No. 94-1121

Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1994

APPLE COMPUTER, INC.,

Petitioner,

v.

MICROSOFT CORPORATION and
HEWLETT-PACKARD COMPANY,

Respondents.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

BRIEF FOR RESPONDENT HEWLETT-PACKARD COMPANY IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Where almost all the content of a computer user interface specified by the copyright owner to constitute the basis for its charge of infringement had been explicitly licensed by the copyright owner for use in a computer user interface, was it error for the courts below to analyze the remaining unlicensed, allegedly infringing content under traditional copyright doctrines to identify expression and determine the scope of protection to which the copyright owner is entitled as against licensee defendants?

2. Where the analysis under traditional copyright doctrines revealed that the only unlicensed expression allegedly in common between the works was *de minimis*, both quantitatively and qualitatively, was it error for the courts below to conclude that illicit copying could be properly inferred only if the works as a whole were virtually identical?

RULE 29.1 STATEMENT

Hewlett-Packard Company has no parent companies or subsidiaries (except wholly owned subsidiaries).

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This brief is submitted by Respondent Hewlett-Packard Company ("HP") in opposition to the Petition for Writ of Certiorari submitted by Apple Computer, Inc. ("Apple"). Respondent Microsoft Corporation ("Microsoft") is submitting a separate opposition.

STATEMENT OF THE CASE

I. INTRODUCTION

Apple brought this action against Microsoft and HP for infringement of the visual displays of certain of Apple's copyrighted software programs.[1] This action is primarily Apple's attempt to evade a perpetual, royalty-free license granted to Microsoft in the settlement of an earlier claim of copyright infringement, which license permits Microsoft to use certain visual displays in its first version of Windows and in future works, and permits Microsoft to sublicense such visual displays to others for use in their works. Almost all of the visual displays that are the subject of Apple's complaint in this action are covered by Apple's license to Microsoft and Microsoft's sublicense to HP; virtually all the other alleged similarities are functions, ideas, and their obvious expression, not protectable under the copyright laws. Moreover, most of these remaining features are further unprotectable because they were not original to Apple, but were taken by Apple from prior works of a similar nature, most notably those of Xerox Corporation ("Xerox").

II. THE MATERIAL FACTS

A. Apple's Graphical User Interfaces Are Tools Used to Operate Computers

Apple's works, the Lisa Desktop and Macintosh Finder software programs, enable persons to file and organize

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[1] Apple's claim of copyright infringement is limited solely to the appearance of visual displays on a computer screen while a program is being run. Apple has not asserted any claims that either Microsoft or HP copied any computer program or underlying computer language code.

documents and other information and to launch software program applications on their respective computers. CR 224 at 2. Users perform these tasks through manipulating various graphic elements, such as pull-down menus, icons, and windows, directly on a computer screen. Such programs, commonly called graphical user interfaces or "GUIs," incorporate graphical elements that allow users to operate a computer in much the same way as a steering wheel, gear shift, brakes, and clutch allow users to operate an automobile. 799 F. Supp. at 1017, 1023 (App. at 99A, 110A). Thus, in the straightforward language of an Apple engineer, "a graphical user interface provides a tool, *a tool in the sense of a hammer.*"[2] CR 499 (Capps Tr. 25-26); *see also* CR 499 (Atkinson Tr. 349; Daniels Tr. 198); 799 F. Supp. at 1017 (App. at 99A).

B. The Development of Apple's Graphical User Interfaces

Lisa Desktop was the graphical user interface for Apple's Lisa computer, which was first sold in 1983. The basic graphic features of this interface, as well as its derivative — the Macintosh Finder — were taken from others, primarily Xerox. 799 F. Supp. at 1027 (App. at 119A). These features include the use of a desktop metaphor for the user interface, overlapping windows, pop-up menus, and page, folder, and waste basket icons. 799 F. Supp. at 1022 (App. at 109A).

The extent of Apple's takings is clear from the history of the Lisa development. When work on the Lisa computer began in 1978, it had a "character-based menu driven user interface [that]

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[2] Emphasis added. Wherever emphasis appears in this Opposition, it has been added unless otherwise indicated.

followed the HP 3000 style."[3] CR 494 Ex. 27. However, in 1979, Apple's founder, Steve Jobs, led a group of Apple engineers to Xerox's Palo Alto Research Center ("PARC") for the first of two demonstrations of Xerox's Smalltalk system. 799 F. Supp. at 1017 (App. at 100A). Smalltalk employed a graphical user interface with overlapping windows, representing papers on a desk, that could be opened and closed. CR 236 (Goldberg Tr. 214-216); 799 F. Supp. at 1017 (App. at 100A). The purpose of the Smalltalk interface was to make a computer easier to use, easier to learn, and more intuitive than the character-based interfaces utilized for computers at that time. 799 F. Supp. at 1017 (App. at 99A-100A). Moreover, the overlapping windows allowed users to maximize the virtual space on the computer's screen much like overlapping papers allow persons to maximize the available surface area of a desk. CR 236 (Goldberg Tr. 214).

Bruce Daniels, a Lisa software manager, described the reaction of the Apple engineers to the Smalltalk interface:

> It was a new way to interact with computers I had never seen before. . . . It used graphics. It used a pointing device to select things. It had a notion of overlapping windows, selecting things out of menus. . . . It was pretty unique.

CR 576 (Daniels Tr. 33-34); *see also id.* at 24, 41, 67-68.

Apple decided instantly to adopt the Smalltalk technology for its new computer. Daniels testified: "It was almost a snap at

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[3] The HP 3000 was a Hewlett-Packard computer with a character- or text-based interface. A character-based interface requires a person to memorize and type in alpha-numeric commands in order to operate a computer. Character-based interfaces are notoriously difficult to learn and use. 799 F. Supp. at 1018 (App. at 101A).

that point. We all said, 'That's it — that's what we want to build.'" CR 494 at Ex. 28.

Larry Tesler, the Xerox employee who gave the Smalltalk demonstration to Jobs, was soon hired away by Apple to run the Lisa project.[4] 799 F. Supp. at 1018 (App. at 100A). When Tesler arrived at Apple for a job interview, he was startled at the "revolution" in the Lisa interface that resulted from the Xerox PARC visit. CR 494 Ex. 27 at 3.

The development of the Lisa interface underwent another dramatic change after the 1981 introduction of Xerox's Star computer. The Star's graphical user interface employed an office metaphor with icons representing familiar office objects such as papers, folders, and in-baskets, to make the computer easy to use and easy to learn. CR 494 Ex. 25 at 13; 799 F. Supp. at 1017-1018 (App. at 100A-101A).

Tesler described the effect of the Star interface on Apple's Lisa engineers: "[I]n a way it was like seeing Smalltalk a year before in terms of inspiration." CR 494 Ex. 31. Subsequently, the non-iconic Lisa interface under development was abandoned and was replaced by a Star-like interface employing an office metaphor with icons representing objects such as papers, folders, and waste baskets. CR 575 (Daniels Tr. at 201, 203); CR 494 Ex. 31. Jonathan Seybold, a noted industry expert, describes the similarity of the Lisa and Star interface as follows: "Lisa bore a strong similarity to the Star — in fact a striking similarity, because there had been nothing else that looked anything like that close to Star before Lisa." CR 575 (Seybold Tr. 143).

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[4] Tesler led a migration to Apple of fifteen to twenty Xerox engineers during the development of Lisa. CR 494 Ex. 23 at 4, Ex. 30.

The Lisa computer was introduced in January 1983 but was "a flop." CR 224 ¶ 2; 799 F. Supp. at 1019 (App. at 102A). In 1984, the Macintosh was introduced. The Macintosh was designed as a low-cost, single-tasking Lisa; the graphical user interfaces of the Lisa and the Macintosh, as admitted by Apple, are "essentially the same." CR 224 at 2 ¶ 2; *see also* 35 F.3d at 1440 (App. at 6A).

The Macintosh computer popularized the graphical user technology pioneered by Xerox and others. Contrary to Apple's suggestion (Petition at 2-3), the success of the product was hardly attributable to the graphical user interface alone. The poor sales of the Xerox Star and Lisa computers demonstrated that innovative computers with graphical user interfaces could and did fail. 799 F. Supp. at 1019 (App. at 102A). The Macintosh sales were, among other things, influenced by low price, brilliant advertising, and the quality of application program software produced for it by developers such as Microsoft. 799 F. Supp. at 1025 (App. at 115A).

C. Windows 1.0 and the 1985 License

In 1983, a year before the Macintosh was introduced, Microsoft announced that it had begun development of its Windows program for IBM-compatible computers. CR 255 (Gates Tr. 172). IBM-compatible computers had a character-based interface and a microprocessor and operating system different from and incompatible with Apple's computers. 799 F. Supp. at 1018-1019 (App. at 102A). Two years later, Windows 1.0 was introduced. This software program allowed IBM-compatible computers to run graphic programs, such as painting and drawing applications, and provided various office-type applications and a graphical user interface. CR 397 at 45-46, 72. The Windows 1.0 interface, unlike the Lisa and Macintosh interfaces, was in color, but like the Lisa and Macintosh interfaces, employed features such as pull-down

menus, a multiple windowing capability, windows with title bars and scroll bars, and document icons. CR 397 at 72, 74, 79, 81, 83.

Contrary to Apple's assertion (Petition at 3), the Windows 1.0 software did not compete with the Lisa or Macintosh interfaces. Apple's interfaces were sold only as pre-installed software for the Apple Lisa and Macintosh hardware. In addition, Windows 1.0 software could not be used on the Lisa or Macintosh computers. Instead, Windows 1.0 provided a graphic capability for IBM-compatible computers that was not previously available. 799 F. Supp. at 1019 (App. at 103A).

Apple complained to Microsoft that the Windows 1.0 graphical user interface infringed Apple's rights in its Lisa Desktop and Macintosh Finder programs. 35 F.3d at 1438 (App. at 1A-2A). Apple and Microsoft ultimately settled their dispute. The element of that settlement agreement (the "1985 License") that is significant to this case is the grant by Apple to Microsoft of a "non-exclusive, world-wide, royalty-free, perpetual" license to the individual visual displays of its Lisa and Macintosh graphical user interfaces that appeared in Windows 1.0 for use "in present and future software programs and to license them to and through third parties for use in their software programs" CR 35 Ex. C., ¶ 5; 35 F.3d 1438 and 1440 (App. at 2A, 6A).

D. Later Versions of Windows

In 1987, Microsoft introduced a new version of its Windows software, Windows 2.03, which continued the graphic style and the visual displays of Windows 1.0. 35 F.3d at 1438 (App. at 2A-3A); 717 F. Supp. at 1433 (App. at 45A-46A). However, Windows 2.03 did provide a new feature that allowed users to overlap windows on their computer screens. Previously, Windows 1.0 provided only a tiling system for multiple windows

that permitted users to place adjacent, but not overlapping, windows on their screens. 35 F.3d at 1438 (App. at 2A-3A); CR 397 at 97-98. In 1990, Microsoft introduced yet another version of its Windows software, Windows 3.0.

In the district court, Apple submitted a "detailed statement identifying with particularity each feature and aspect of its copyrighted visual displays said to be infringed" by the accused works. CR 236 Ex. A. Apple claimed 189 items of similarity between its works and the interface provided by Windows 2.03. However, of those 189 alleged similarities, 179 were visual displays also found in Windows 1.0 and therefore had been licensed by Apple. 799 F. Supp. at 1016 (App. at 96A). The ten remaining supposedly similar elements were items relating to overlapping windows and icon movement, such as overlapping windows in front of a muted background (Item A1) (799 F. Supp. at 1027 (App. at 119A)), having the top window as the active window (Item B1) (799 F. Supp. at 1032 (App. at 127A)), moving a window to the top of a stack of overlapping windows by "clicking" on it with the "mouse" (Item B2) (799 F. Supp. at 1033 (App. at 128A)), having the name of an icon centered beneath the icon (Item G6) (799 F. Supp. at 1034 (App. at 131A)), and dragging an outline of a window along with the cursor when the mouse is pressed (Item D1) (799 F. Supp. at 1033 (App. at 128A)).[5]

All these elements are ideas, processes, or standard treatments for graphical user interfaces.[6] Moreover, the idea of

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[5] The alphanumeric designations, such as A1, B1, etc., were used by Apple to identify the particular items of claimed similarity in the detailed statement submitted to the district court.

[6] Apple states that there are an infinite number of ways to arrange windows on a screen so that they overlap. Petition at 8. This is true in only one (continued...)

overlapping windows was not new to Apple; it was used before by Xerox and others. 799 F. Supp. at 1027 (App. at 119A)).

E. NewWave

NewWave 1.0 was introduced to the public in 1989, more than a year after Apple had brought this action against Microsoft and HP. Apple had sued HP shortly after the announcement of the NewWave Developer Release, a crude, partially-functioning version of NewWave that was distributed only as an aid to software developers in anticipation of later, fully-functioning versions. HP released a subsequent version of NewWave, NewWave 3.0, in 1990 around the same time Microsoft introduced its Windows 3.0 product.[7] CR 397 153-54; CR 661.

NewWave is a software program that runs in conjunction with Windows. Its use of the visual displays of Windows 1.0 is licensed by Microsoft in accordance with the 1985 License. 821 F. Supp. at 626-627 (App. at 181A-182A). NewWave provides many features to make IBM-compatible computers easier to use and more automated. Significantly for this case, NewWave extended the office metaphor of Windows to add icons representing, for example, documents, folders, a file drawer, a waste basket, a printer, and an innovative "agent" that executes automated tasks, and to add functions such as stacking documents and straightening up icons. CR 397 at 123-154.

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[6](...continued)
sense — if one is referring to a user's ability to arrange different combinations and sizes of windows on a screen. It is most emphatically not true if one is referring to a programmer's choice of windowing systems displaying multiple windows. As to these, there are only the choices of overlapping windows or tiled windows. 35 F.3d at 1444 (App. at 15A).

[7] There never was a NewWave version designated "NewWave 2.0."

As with Windows 2.03 and 3.0, Apple provided a detailed list of claimed similarities between its Lisa and Macintosh interfaces and the NewWave interfaces. Apple identified 147 similarities, but 93 of those claimed similarities were covered by the 1985 License. 799 F. Supp. at 1016 (App at 96A). Virtually all the 54 remaining claimed similarities were for features not original to Apple, were ideas, procedures, or methods of operation, were expressions that merged with an idea, or were "stock scenes" for a graphical user interface.

Examples of the kind of claimed similarities that are *not original to Apple* are Items G11 and G12, as quoted from Apple's list:

> G11 - The design and layout in Macintosh presents an icon image shaped like a file folder to indicate objects of type "directory." NewWave presents the same design, appearance and style.
>
> G12 - The design and layout in Macintosh presents icon images shaped like a page with a turned-down corner to indicate objects of a type other than "directory." NewWave presents the same design, appearance and style.

799 F. Supp. at 1034-1035 (App. at 131A-132A). However, icons shaped like file folders and like pages with turned-down corners were used in the Xerox Star and were not original to Apple. 799 F. Supp. at 1035 (App. at 94A, 132A-133A).

Apple's identification of a *pure idea* as a basis of similarity and copyright protection is illustrated by Item G10:

> G10 - The design and layout in Macintosh associates a different icon image with each type of object and indicates the type of each object by presenting the object as the icon image corresponding to its type.

799 F. Supp. at 1034 (App. at 131A). This item simply claims that the works use icons, but the use of icons is a fundamental idea of graphical user interfaces. 35 F.3d at 1443-1444 (App. at 14A); 799 F. Supp. at 1026 (App. at 117A-118A).

An example of Apple's claim of a similarity that is *merely expression that merges with an idea* is shown by Item G2:

> G2 - The design and layout in Macintosh stores permanently on disk the positions of icons so that at the beginning of a session all icons have the same positions that they had at the end of previous session.

799 F. Supp. at 1039-1040 (App. at 141A-142A). This is merely a claim that the arrangement made by a user of icons on a screen is preserved when the use of the software ends. There is no distinction between the idea of preserving the icon's place and the expression depicting preservation of that place. 799 F. Supp. at 1040 (App. at 94A, 142A).

F. Apple's Contentions Regarding Originality, Substantial Similarity, and Design Alternatives

Apple makes three principal contentions in its statement of material facts that concern (1) originality, (2) substantial similarity, and (3) design alternatives. Petition at 5-8.

First, Apple states that its *works* are original, a matter not in dispute. More pertinently, however, many of the *similarities* it claims, such as overlapping windows, the use of icons, or icons shaped like folders or pages with turned-down corners, were taken by Apple from others. 799 F. Supp. at 1031-1032, 1034-1035 (App. at 126A, 131A-132A).

Second, Apple claims that there is "overwhelming" evidence that Windows and NewWave are "substantially similar" to

Apple's works. Petition at 5-6. It was established beyond reasonable dispute, however, that all or virtually all of the similarities that Apple could identify between its works and the Windows and NewWave interfaces were licensed elements or ideas, processes, or displays that flow naturally from the ideas used in graphical user interfaces.

Moreover, Apple has never identified the "unique arrangement" of its Lisa and Macintosh interfaces, and certainly has never identified any allegedly similar arrangement in the works of Microsoft and HP. Petition at 7; 799 F. Supp. at 1022-1023 (App. at 109A-110A). All Apple has pointed to as its arrangement are the general concepts or ideas that make up the desktop metaphor, something neither original to Apple nor susceptible of exclusive rights under copyright law. 35 F.3d at 1443-1444 (App. at 13A-14A); 799 F. Supp. at 1022-1023 (App. at 109A-110A). The superficial resemblance of the Windows and NewWave interfaces to Apple's interfaces, quite like the similarity of Apple's interfaces to Xerox's Smalltalk and Star interfaces, arises because they are graphical user interfaces employing similar metaphors and having similar technical constraints.

Further, the respective overall structure and methods of operation of Windows and NewWave are, in fact, significantly different from those of the Lisa and Macintosh interfaces. CR 397. This was dramatically illustrated by Bernard Galler, Apple's expert, who, although intimately familiar with the operation of the Macintosh, was unable to operate the Windows interface during his deposition. CR 527 (Galler Tr. 136-138).

Finally, Apple claims that there were many design alternatives available to defendants. Petition at 5-6, 7-8. The features of a graphical user interface, however, are not arbitrary. They are limited by (1) the conceptual model — in this case the desktop or office metaphor — upon which the interface is based,

(2) constraints imposed by the limitations of the computer, and (3) engineering design principles such as the need for consistency, feedback for the user, and ease of use. 35 F.3d at 1443-1445 (App. at 14A-16A). Thus, for example, hardware constraints limit the number of ways the movement of a window can be depicted graphically on a screen. *Id.* at 1445.

REASONS FOR DENYING THE PETITION

I. SUMMARY OF ARGUMENT

Apple's Petition mounts vigorous attacks on rulings that were never made. Apple's allegations notwithstanding, the Ninth Circuit *did not* announce a new rule for the scope of copyright protection for computer user interfaces, nor did it set different standards for copyright infringement for computer-related works than for any other type of work. Rather, the Ninth Circuit affirmed the interpretation of the 1985 Apple-Microsoft license agreement (now conceded by Apple to be correct), endorsed the application of traditional copyright analysis to the few items in controversy that were not covered by the license, and confirmed the ruling below that the qualitatively and quantitatively *de minimis* unlicensed expression remaining in this particular case deserved only a narrow range of protection.

There is plainly no conflict between the Ninth Circuit's rulings and those of any other circuit. All circuits must examine the scope of protection to be afforded to any particular work based upon the original, protectable content of the work, and no special rules for computer-related works prevail. Apple's attempt to find a conflict between Ninth and Tenth Circuit cases, as to *when* analysis of protectable expression should be done, does not create a conflict as to *whether* or *how* such analysis should be performed. It is revealing that Apple has not alleged that a different sequence of the analysis would even have

changed the result in the present case, for clearly it would make no difference whatever.

This case presents no broad issues of copyright law for consideration by the Court. Instead, the rulings below reflect a fact-intensive and fact-specific dispute, in which the outcome was determined principally by the terms of a license agreement no longer in issue.

II. ARGUMENT

A. THE NINTH CIRCUIT DID NOT APPLY A NEW OR DIFFERENT INFRINGEMENT STANDARD FOR GRAPHICAL USER INTERFACES

Apple has resorted to gross mischaracterizations of the decisions below to create the false impression of a significant departure from well-settled principles of copyright law. But the Ninth Circuit did not, as Apple insists, announce a new general rule that virtual identity is the proper infringement standard for all graphical user interfaces. Rather, the Court of Appeals simply held that virtual identity is the proper infringement standard for the particular works in issue in this case, because those works have a narrow range of protectable and unlicensed expression. Clearly, the Ninth Circuit's actual decision is entirely consistent with long-established copyright law precepts.

Apple must premise its Petition on a misdescription of the Ninth Circuit's decision as holding that "'the appropriate standard for illicit copying [of computer graphical user interfaces] is virtual identity' because computer graphical user interfaces are 'partly functional . . . a tool to facilitate communication between the user and the computer' [35 F.3d at 1439, 1444 (App. at 5A, 15A)]." Petition at 10 (bracketed material inserted by Apple). In fact, the foregoing bracketed

insertion and juxtaposition of quotations from widely separated portions of the Ninth Circuit's opinion grossly distort the decision below.

The bracketed insertion misrepresents the decision as holding that the virtual identity standard applies to all "computer graphical user interfaces." Actually, the virtual identity standard was applied solely to the works in suit, and only because the similarities they have in common consist almost entirely of unprotectable elements:

> Having found that the similarities in Windows 2.03 and 3.0 consist only of unprotectable or licensed elements, and that the similarities between protectable elements in Apple's works and NewWave are de minimis, the district court did not err by concluding that, to the extent there is creative expression left in how the works are put together, as a whole they can receive only limited protection. *When the range of protectable and unauthorized expression is narrow, the appropriate standard for illicit copying is virtual identity. For these reasons,* the GUIs in Windows 2.03, 3.0 and NewWave cannot be compared for substantial similarity with the Macintosh interface as a whole. Instead, as the district court held, the works must be compared for virtual identity.

35 F.3d at 1439 (App. at 5A). Thus, it was not the computer-related character of the work that made the virtual identity standard appropriate, but rather the narrow range of the protectable and unauthorized expression that was the subject of dispute. *Id.*

Apple also suggests that the Ninth Circuit applied the virtual identity standard because computer graphical user interfaces are partly functional. Petition at 10. But to make its point, Apple has had to juxtapose one quotation dealing with the proper

infringement standard, 35 F.3d at 1439 (App. at 5A), with another quotation dealing with the appropriateness of applying the *scenes a faire* doctrine[8] to features of the works, 35 F.3d at 1444 (App. at 15A). When seen in full context, it is clear that the Ninth Circuit was addressing only the latter issue of *scenes a faire*:

> Apple suggests that *scenes a faire* should not limit the scope of its audiovisual copyright, or at least that the interactive character of GUIs and their functional purpose should not outweigh their artistry. While user participation may not negate copyrightability of an audiovisual work, the district court did not deny protection to any aspect of Apple's works on this basis. In any event, unlike purely artistic works such as novels and plays, *graphical user interfaces generated by computer programs are partly artistic and partly functional. They are a tool to facilitate communication between the user and the computer* . . . .

35 F.3d at 1444 (App. at 15A) (citations omitted).

Apple goes on to attack other phantom rulings. For example, Apple complains of a fictitious holding that "copyright protection in effect is not available for the structure, sequence and organization of a computer graphical user interface, that is, for the work as a whole [35 F.3d at 1445 (App. at 16A-17A)]." Petition at 10. No such ruling can be found at the cited page, or anywhere else. To the contrary, the cited portion of the opinion actually provides a straightforward application of the rule in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 348-51 (1991), that protection extends only to

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[8] That doctrine is one of the "[w]ell-recognized precepts [that] guide the process of analytic dissection." 35 F.3d at 1444 (App. at 14A).

those components of a work that are original to the author, and thoroughly discusses the necessity of applying the same analysis to all types of works, including their non-literal elements, as recognized by several other circuits. 35 F.3d at 1445 (App. at 16A-17A).

Actually, the courts below clearly recognized that copyright protection is available for each of Apple's works as a whole, but that such protection is limited here by the license to Respondents and by the tiny quantum of protectable, unlicensed expression that the works in issue have in common. In particular, the Ninth Circuit held that:

> [T]he party claiming infringement may place "*no* reliance upon any similarity in expression resulting from" unprotectable elements. Otherwise, there would be no point to the extrinsic test, or to distinguishing ideas from expression. In this case, it would also effectively rescind the 1985 Agreement. *This does not mean that at the end of the day, when the works are considered under the intrinsic test, they should not be compared as a whole.* Nor does it mean that infringement cannot be based on original selection and arrangement of unprotected elements. However, the unprotectable elements have to be identified, or filtered, before the works can be considered *as a whole.*

35 F.3d at 1446 (App. at 18A-19A) (first emphasis in original). Moreover, the court of appeals found:

> The district court's conclusion that *the works as a whole are entitled only to limited protection* and should be compared for virtual identity follows from its analytic dissection. By virtue of the licensing agreement, Microsoft and HP were entitled to use the vast majority of features that Apple claims were copied. Of those that

> remain, the district court found no unauthorized, protectable similarities of expression in Windows 2.03 and 3.0, and only a handful in NewWave. Thus, any claim of infringement that Apple may have against Microsoft must rest on the copying of Apple's unique selection and arrangement of all of these features. Under *Harper House* and *Frybarger*, there can be no infringement unless the works are virtually identical.

35 F.3d at 1446 (App. at 19A).[9]

There can be no doubt in this case that Apple was given a full and fair opportunity to have its works considered as whole before a jury, but that it passed up that opportunity by failing to oppose HP's and Microsoft's motions for summary judgment of noninfringement. "Apple could have gone to the jury under a virtual identity standard, but elected not to." 35 F.3d at 1447 (App. at 20A).

It is well beyond reasonable dispute that, contrary to Apple's mischaracterizations, the Ninth Circuit neither announced a new rule for graphical user interfaces nor denied protection to Apple's works as a whole. The court of appeals merely affirmed that Apple could recover against its licensees only if the works as a whole were virtually identical, because the unlicensed portions of Apple's works have only a narrow range of protectable or protected expression. Thus, properly considered,

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[9] That the Ninth Circuit relied on its earlier decisions in *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197 (9th Cir. 1989) (works in suit were organizer diaries), *cert. denied*, 114 S. Ct. 1058 (1990), and *Frybarger v. International Business Machines Corp.*, 812 F.2d 525 (9th Cir. 1987) (screen displays of video games), in which the works in suit did not relate to computer graphical user interfaces, further demonstrates that its ruling did not enunciate a new or different infringement standard for such works.

none of the rulings by the court of appeals is contrary to well-established principles of copyright law.

B. THE DECISION OF THE NINTH CIRCUIT CREATES NO CONFLICT WITH ANY OTHER COURT OF APPEALS

Having fabricated a set of rulings (as described *supra*) bearing scant resemblance to the actual decision below, Apple then goes on to argue that those fictitious rulings are in conflict with decisions of other circuits. Seeking to maximize the synthetic conflict thus produced, Apple further compounds matters by misconstruing the supposedly conflicting decisions of other courts of appeals, ignoring pivotal factual distinctions and mistaking semantic variations for analytical differences.

First, Apple alleges that:

> [T]he Ninth Circuit is the only circuit that has adopted a "virtually identical" infringement standard for graphical user interfaces and rejected comparison of such works as a whole under the "substantial similarity" standard. In so departing from traditional legal norms, the court below has created conflicts among the circuits and uncertainty in an important area of the law.

Petition at 13. Of course, as explained *supra*, the Ninth Circuit did not adopt the virtual identity standard for all graphical user interface works. The court of appeals held simply that because the vast majority of the alleged similarities between Apple's works and the accused works were licensed to defendants or unprotectable under copyright law (with the result that Apple's works were protectable as against the defendants only as a selection and arrangement of mostly unprotectable elements), infringement could not be found absent virtually identical

copying. Since no circuit has in fact ever adopted the straw man rule posited by Apple, there is no conflict among the circuits.[10]

Contrary to Apple's contentions, the Ninth Circuit's decision rests solidly upon a foundation of such well-settled copyright law principles as the idea-expression dichotomy, originality, merger, and *scenes a faire*. The actual rulings by the Ninth Circuit — that identifying protectable and protected expression is essential to analyzing a claim of copyright infringement, and that infringement by accused works containing little or no such expression allegedly taken from copyrighted works is assessed under the virtual identity standard — are fully consistent with the decisions of other courts of appeals. *See Engineering Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1342-43 (5th Cir. 1994); *Fisher-Price, Inc. v. Well-Made Toy Mfg. Corp.*, 25 F.3d 119, 123 (2d Cir. 1994); *Gates Rubber Co. v. Bando Chem. Indus.*, 9 F.3d 823, 834, 841 (10th Cir. 1993); *Computer Assocs. Int'l., Inc. v. Altai, Inc.*, 982 F.2d 693, 706-11 (2d Cir. 1992); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 672, 679-80 (2d Cir. 1980). The actual decision below is therefore fully in accord with traditional legal norms and creates neither conflicts among the circuits nor uncertainty within any of them.

Second, a careful examination of the cases that Apple cites from other circuits reveals that no conflict exists. For example,

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[10] Apple does not limit its departures from the record to misstatements about the substantive rulings below. Apple has also submitted (as Part III of the Appendix to the Petition) more than 40 pages of a purported "collation of selected record excerpts." That submission actually reflects a careful cropping, editing, selecting, and rearranging of materials presented for persuasive effect, and is in essence an additional forty pages of briefing. Apple attempted improperly to slip a quite similar submission into the record before the Ninth Circuit, but it was ordered stricken on June 17, 1994. It certainly does not constitute part of the record on appeal. It is conduct of this nature that has prompted defendants to seek recovery of attorney fees under the applicable provision of the copyright laws for all phases of this action.

Apple maintains that other circuits have used a substantial similarity standard rather that a virtual identity standard. Petition at 13-14 (citing *Atari Games Corp. v. Nintendo of Am., Inc.*, 975 F.2d 832, 844-45 (Fed. Cir. 1992); *Whelan Assocs. v. Jaslow Dental Lab.*, 797 F.2d 1222, 1242-48 (3d Cir. 1986), *cert. denied*, 479 U.S. 1031 (1987); *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 445-46 (4th Cir. 1986)). Not one of those cases, however, involved a work that consisted almost entirely of licensed and unprotectable material. In each of those instances, under the unique facts presented, substantial similarity was an appropriate test, just as the virtual identity standard was appropriate on the facts in this case.

No circuit chooses between substantial similarity and virtual identity *categorically* based upon whether a computer user interface is involved, and it is unworthy to suggest otherwise. The standard properly depends on the range of expression available, based on the particular facts presented. *See Feist*, 499 U.S. at 349 (when selection and arrangement is the only protectable expression in a factual compilation the copyright protection is thin).

Finally, alluding to a suggestion in *Gates Rubber*, Apple contends that "there is a sharp split among the circuits that have employed a version of the 'dissection and filtration' approach as to whether a comparison between the plaintiff's work and the defendant's should be made *before* the dissection and filtration or afterwards." Petition at 22-23 (emphasis in original). Apparently, Apple now believes that the sequence of the analysis is significant. However, no such argument was ever offered by

Apple below. To the contrary, Apple urged that the analysis should not be done at all.[11]

The hollow nature of Apple's newly found concern is further revealed by Apple's inability even to suggest any way in which the ultimate result might be altered by a variation in the sequence of the analysis. Clearly, Apple has searched desperately for a difference in the circuits, portraying whatever it might find as a meaningful conflict that justifies the issuance of a writ, without showing any relevance whatsoever to this lawsuit.

Furthermore, Apple misperceives the reasoning of the Tenth Circuit in *Gates Rubber*. The purpose of the suggested early comparison is to assist a court "in determining the factual issue of copying"; it does not substitute for or change the nature of the analysis to determine scope of protection. *Gates Rubber*, 9 F.3d at 841. Indeed, the Tenth Circuit explicitly observed that "[s]uch a preliminary step does not obviate the ultimate need to compare just the protected elements of the copyrighted program with the alleged infringing program." *Id.*

It is beyond peradventure that the courts of appeals uniformly employ an analysis to identify protected and protectable expression in a copyrighted work. Consequently, the decision of the Ninth Circuit in this case creates no conflict with the other circuits.

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[11] As the court of appeals noted, "Apple's arguments [were] that the district court shouldn't have dissected at all, or dissected too much; that it 'filtered out' unprotectable and licensed elements instead of viewing the Macintosh interface as a whole; and that it should have recognized protectability of arrangements and the 'total concept and feel' of the works under a substantial similarity standard." 35 F.3d at 1445 (App. at 17A).

C. THIS CASE PRESENTS NO ISSUES WORTHY OF CERTIORARI

The outcome of this case was determined ultimately by the interpretation of a license agreement that is no longer in dispute. The contours of the issues are tied inextricably to the unique licensing terms negotiated between Microsoft and Apple (and applicable to HP as a sublicensee) and such issues have no bearing on other litigants, other copyrights, or other courts.

Although of great importance to the parties, the decisions below do not establish rules of general applicability and importance to the legal system of the nation. Instead, they reflect years of careful and painstaking work by the courts below in applying traditional copyright law principles to a unique situation of great factual complexity. No inconsistency with precedent has been or can be shown.

CONCLUSION

For the foregoing reasons, this Court should deny the Petition.

Respectfully submitted,

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